


determining whether a particular invention is obvious in light of the prior art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S. Ct. 684, 694 (1966); *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 1573 (Fed. Cir. 1985). These include the filling of a long-felt but unsatisfied need in the art, failure of others to solve the problem, the fact that the prior art taught away from the invention, and a showing of commercial success. These factors should be considered on a case-by-case basis. *John Deere*, 383 U.S. at 18.

The affidavit submitted with this Amendment demonstrates several of these factors in the present case. It shows that practitioners in this area had long desired a better vehicle in which to deliver the medication that so effectively treats Peyronie's disease. The practitioner in this case, in view of the "excruciating pain" involved with the only vehicle available at the time—injections—would typically recommend a "wait-and-see approach." Hardly a satisfying solution to such an embarrassing disease. No where in the art, prior to the present invention, did any one teach or suggest the painless and convenient delivery method of the present invention. In addition, the skepticism of the practitioners of this field can be seen in the affidavit. Affiant admits to extreme skepticism as to the efficacy of the present invention "[i]n view of the dismal efficacy of prior treatment regimens which involved direct intervention with the plaques of Peytonie's disease." The prior art actually taught away from the present invention. And finally, it is clear from the enthusiasm of the affiant that commercial success is assured for the present invention. Practitioners will welcome such an addition to their arsenal in the fight against Peyronie's disease.

In view of the above and the attached evidence, it is submitted that Claims 16 and 17 are in a condition for allowance. Reconsideration and withdrawal of the rejections and objections are hereby requested. Allowance of Claims 16 and 17 at an early date is solicited.

If impediments to allowance of Claims 16 and 17 remain and a telephone conference between the undersigned and the examiner would help remove such impediments in the opinion of the examiner, a telephone conference is respectfully requested.

Respectfully submitted,



David G. Henry
Registration No. 32,735
900 Washington Ave.
P.O. Box 1470
Waco, TX 76703-1470
(254) 755-4234
(254) 754-6331 (Fax)
henry@namanhowell.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 7 day of Sept. 9/7/04, 2004.



David G. Henry